



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,149	02/20/2004	Andreas Richter	081583-0294	5352

26371 7590 01/31/2005

FOLEY & LARDNER
777 EAST WISCONSIN AVENUE
SUITE 3800
MILWAUKEE, WI 53202-5308

EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,149

Applicant(s)

RICHTER ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004 and 16 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1774

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to an organic electroluminescent device, classified in class 428, subclass 690.
- II. Claims 10-13, drawn to a 2,5-diaminoterephthalic acid derivative, classified in various subclasses of class 546 and 548 dependent upon the specifics of the R variables. For example, when R^2 and R^3 form a 6-membered unsaturated heterocycle, R^6 and R^7 form a 6-membered unsaturated heterocycle, and at least one of R^{10} and R^{11} is $-C(=O)-X^{2/4}R^{1/5}$, the compound is classified in class 546, subclass 267, whereas when R^2 and R^3 form a 5-membered unsaturated heterocycle, R^6 and R^7 form a 5-membered unsaturated heterocycle, and at least one of R^{10} and R^{11} is $-C(=O)-X^{2/4}R^{1/5}$, the compound is classified in class 548, subclass 530.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require that R^2 and R^3 form a 5- or 6-membered, saturated or unsaturated, ring, does not require that R^6 and R^7 form a 5- or 6-

Art Unit: 1774

membered, saturated or unsaturated, ring, and does not require that A be a triply unsaturated benzene ring. The subcombination as claimed also encompasses 2,5-diaminoterephthalic acid derivatives that are outside the scope of the at least one 2,5-diaminoterephthalic acid derivative required for the combination as claimed because the subcombination does not place any limitation on the substituents for the recited "substituted aryl" and "substituted heteroaryl" whereas the combination does. The subcombination has separate utility such as in a fluorescent anticounterfeiting or antitheft composition.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

In addition to the preceding restriction requirement, an election of species is required. For purposes of the election of species requirement, claim 10 is interpreted as if X^1 - X^4 have the same definitions as X^1 - X^4 in claim 1. Currently, claim 10, with claims 12 and 13 dependent therefrom, do not define X^1 - X^4 .

This application contains claims directed to the following patentably distinct species of the claimed invention:

In the case of Group I, an organic electroluminescent device comprising a compound of formula 1a wherein

(A) A is a triply unsaturated benzene ring or

(B) A has two isolated double bonds in the 1,2-position and the 4,5-position; and

Art Unit: 1774

for (A) or (B)

(i) each of R^{10} and R^{11} is $-CN$ or

(ii) R^{10} is $-C(=X^1)-X^2R^1$ and R^{11} is $-C(=X^3)-X^4R^5$ or

(iii) R^{10} is $-CN$ and R^{11} is $-C(=X^3)-X^4R^5$, or R^{10} is $-C(=X^1)-X^2R^1$ and R^{11} is $-CN$,

and for (ii) or (iii)

each X^1 and X^3 is independently (a) oxygen, (b) sulphur or (c) imino and

each X^2 and X^4 is independently (d) oxygen, (e) sulphur or (f) amino.

In the case of Group II, a compound of formula 20a wherein

(i) each of R^{10} and R^{11} is $-CN$ or

(ii) R^{10} is $-C(=X^1)-X^2R^1$ and R^{11} is $-C(=X^3)-X^4R^5$ or

(iii) R^{10} is $-CN$ and R^{11} is $-C(=X^3)-X^4R^5$, or R^{10} is $-C(=X^1)-X^2R^1$ and R^{11} is $-CN$,

and for (ii) or (iii)

each X^1 and X^3 is independently (a) oxygen, (b) sulphur or (c) imino and

each X^2 and X^4 is independently (d) oxygen, (e) sulphur or (f) amino.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, (A)(i) and (A)(ii)(a)(a)(d)(d) are two species of the invention of Group I. (A)(i) is the species in which A is a triply unsaturated benzene ring and each of R^{10} and R^{11} is $-CN$. (A)(ii)(a)(a)(d)(d) is the species in which A is a triply unsaturated benzene ring,

Art Unit: 1774

R^{10} is $-C(=X^1)-X^2R^1$, R^{11} is $-C(=X^3)-X^4R^5$ and each of X^1-X^4 is oxygen. In addition, applicant is required to select an ultimate species (specific compound) that will be used as the starting point for search and examination purposes. Currently, claim 1 is generic with respect to the Group I invention, and claim 10 is generic with respect to the Group II invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Charles Carter on January 25, 2005, but did not result in an election being made. More details regarding the telephone call are set forth later in this action.

Art Unit: 1774

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

The declaration is directed to PCT Application No. PCT/DE02/031110, filed 21 August 2002. The present application is not a 371 application of the indicated PCT application, and is not a continuation or a divisional of a 371 application of the indicated PCT application.

Art Unit: 1774

Therefore, the declaration does not properly identify the specification to which the declaration is directed.

Based on the communications received August 16, 2004, the declaration filed in the present application is a copy of a declaration and power of attorney originally filed in copending Application No. 10/487,138. (The paper headed "COMMUNICATION" indicates that the U.S. National Stage Application of PCT/DE02/03110 has been designated Application No. 10/784,149. 10/784,149 is the present application. The correct Application No. for the U.S. National Stage Application of PCT/DE02/03110 is 10/487,138.) While the present application is in the same family as 10/487,138, the present application is not a continuation or a divisional of 10/487,138. The specification, including the claims, of the present application is not the same as the specification, including the claims, of copending Application No. 10/487,138 or PCT/DE02/03110. Accordingly, it is not clear that the person making the declaration has reviewed and understands the contents of the present specification, including the claims.

In order for a reply to this action to be complete, applicant must make a complete response to the restriction and election of species requirements. Applicant need not provide a new oath or declaration in order for the reply to be complete.

The present application was originally filed with an application data sheet (ADS) and no executed oath or declaration. The ADS provides a correspondence customer number of 26371 and a representative customer number of 26371.

Art Unit: 1774

The correspondence address has been established based on the ADS. The correspondence address set forth in the executed declaration filed August 16, 2004, which is different than the address set forth in the ADS, does not affect the correspondence address. See MPEP 601.03.

The representative customer number set forth in the ADS does not establish power of attorney for the application. See MPEP 601.05. Power of attorney is established by the executed declaration filed August 16, 2004, which provides power of attorney to attorneys other than those associated with the representative customer number set forth in the ADS.

Accordingly, correspondence will be mailed to Foley & Lardner LLP in Milwaukee, Wisconsin, while the power of attorney lies with the attorneys named in the executed declaration, who are apparently from Pendorf & Cutliff in Tampa, Florida.

Charles Carter (Reg. No. 35,093) of Foley & Lardner LLP has signed all communications submitted in the present application which require the signature of a registered patent attorney or agent. On January 25, 2005, the undersigned examiner left a voice mail message for Mr. Carter in an effort to determine if a change in power of attorney had been filed for the present application but not scanned into the IFW. The examiner also indicated that restriction and election of species requirements were going to be made, but the specifics of the requirements were not set forth in the voice mail message since Mr. Carter does not appear to have power of attorney. No response to the telephone call has been received.

Art Unit: 1774

Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for Art Unit 1774 is (703) 872-9306 for all official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
January 27, 2005



MARIE YAMNITZKY
PRIMARY EXAMINER

1774